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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MATZ, *et al.*

Group Art Unit: 3622

Application No. 10/017,111

Examiner: ALVAREZ, Raquel

Filed: December 14, 2001

Attorney Docket: BS01372

Title: "Method and System for Targeted Incentives"

APPELLANT'S BRIEF IN SUPPORT OF APPEAL

Mail Stop: Appeal Brief — Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The Assignee/Appellant hereby submits three (3) copies of a Brief in Support of Appeal for the above-identified application. This Brief is accompanied by a credit card authorization form to charge the 37 C.F.R. § 41.20 (b) (2) large entity fee of \$500.00.

A Notice of Appeal was filed February 21, 2006. This Notice of Appeal was accompanied by a Pre-Appeal Brief Request for Review. The panel's decision was mailed March 29, 2006, and the panel maintained the final rejection of the pending claims.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

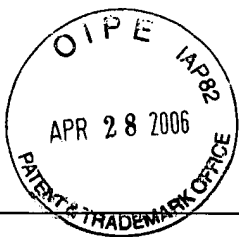
Respectfully submitted,

Scott P. Zimmerman, Reg. No. 41,390

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BS01372

U.S. Application No. 10/017,111 Examiner ALVAREZ, Art Unit 3622
Appellant's Brief in Support of Appeal

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APPELLANT'S BRIEF IN SUPPORT OF APPEAL

REAL PARTY IN INTEREST

BellSouth Intellectual Property Corporation, as assignee of U.S. Patent Application 10/017,111, is the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences pertaining to the above-identified application.

STATUS OF CLAIMS

Claims 1-4, 6-15, and 18-38 have been finally rejected under 35 U.S.C. § 103 (a) as being obvious over WO 99/45702 to Knudsen.

The Appellant appeals this final rejection of claims 1-4, 6-15, and 18-38.

STATUS OF AMENDMENTS

No amendments have been submitted subsequent to the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter generally relates to marketing and, more particularly, to targeting incentives to users to purchase products and/or services. Consumers are often overwhelmed by the volume of advertisements seen in television, in magazines, on the Internet, and in other media venues. Exemplary embodiments, then, cut through this clutter of advertisements by collecting the user's television viewing selections and the user's credit card purchase records. The credit card purchase records describe the user's purchases from retail stores. When the user's television viewing selections relate to the user's purchases from retail stores, the user is classified in a classification and a coupon or other incentive may be sent to that user.

Some examples from the application may be helpful. Suppose the user's television viewing selections indicate that the user watches stock car racing. The user, then, might be classified as a "stock car viewer." If the user's credit card purchase records also indicate that model cars are bought, then the user may be sent an incentive to purchase a stock car die cast model. *See, e.g.*, paragraphs [0041], [0042], and [0053] of the as-filed application.

Another example may be helpful. Suppose the user's television viewing selections indicate that the user has viewed advertisements for soft drink "A" and for soft drink "B." The user's credit card purchase records also indicate that the user regularly buys soft drink "B" at the grocery store. Because the user viewed advertisements for brand "B" and also bought brand "B," the user is classified as a viewer/buyer of brand "B" soft drinks. An advertiser for brand "A," then, might send an incentive to the user to purchase soft drink "B." The user's credit card purchase records could be monitored to determine whether the user switched brands. Advertisers, then, may use the user's television viewing selections and the user's credit card

purchase records to determine the effectiveness of advertising campaigns. *See, e.g.*, paragraphs [0049] through [0051] of the as-filed application.

A) Claim 1

In accordance with an exemplary embodiment, claim 1 recites a method for marketing, comprising:

- defining a match between a user classification and an incentive;
- receiving from a set-top box user data associated with a user's television viewing selections;
- receiving the user's credit card purchase records describing purchases from retail stores;
- classifying the user in a user classification when the user's television viewing selections relate to the user's purchases from the retail stores; and
- transmitting the incentive to the user if a match is defined between the user classification and the incentive.

Textual support for claim 1 is also provided. A match is defined between a user classification and an incentive (*see, e.g.*, paragraph [0015] at page 5, lines 6-7; paragraph [0044] at page 12, lines 20-31; at paragraphs [0052] through [0054]; at paragraph [0059]; and at FIG. 6). User data associated with a user's television viewing selections is received from a set-top box (*see, e.g.*, paragraph [0031] at page 7, lines 25-32; and at paragraphs [0033] and [0036]). The user's credit card purchase records describing purchases from retail stores are received (*see, e.g.*, paragraph [0016] at page 5, lines 15-25; paragraph [0034] at page 9, lines 10-25; and at paragraphs [0035] and [0051]). The user is classified in a user classification when the user's television viewing selections relate to the user's purchases from the retail stores (*see, e.g.*, paragraph [0016] at page 5, lines 15-25; paragraph [0020] at page 6, lines 6-10; paragraph [0033] at page 8, lines 23-24; paragraph [0034] at page 9, lines 12-15; and at paragraphs [0035], [0041], [0042], and [0049]). The incentive is transmitted to the user if a match is defined between the

user classification and the incentive (*see, e.g.*, paragraph [0029] at page 7, lines 7-9; paragraph [0033] at page 9, lines 2-9).

B) Claim 15

In accordance with another exemplary embodiment, claim 15 recites a system for delivering targeted incentives to a user, comprising:

a server in communication with a set-top box;

user data stored on the server, wherein said user data is collected from a plurality of sources comprising the user's television viewing selections from the set-top box and the user's credit card purchase records describing purchases from retail stores; and

a classification module in communication with the server configured for defining a match between a user classification and an incentive, and classifying the user in the user classification when the user's television viewing selections relate to the user's purchases from the retail stores.

Textual support for claim 15 is provided. A server is in communication with a set-top box (*see, e.g.*, paragraphs [0030] through [0033] and FIG. 1). User data is stored on the server, wherein said user data is collected from a plurality of sources comprising the user's television viewing selections from the set-top box and the user's credit card purchase records describing purchases from retail stores (*see, e.g.*, paragraph [0033] at page 8, lines 23-24; paragraph [0034] at page 9, lines 12-15; at paragraphs [0035], [0041], [0042], and [0049]; and at FIGS. 1-3). A classification module is in communication with the server and configured for defining a match between a user classification and an incentive, and classifying the user in the user classification when the user's television viewing selections relate to the user's purchases from the retail stores (*see, e.g.*, paragraph [0040] at page 11, lines 1-9; paragraph [0041] at page 11, lines 10-24; paragraph [0042] at page 12, lines 1-2; paragraphs [0043] and [0044] at page 12, lines 3-31; and at paragraphs [0048] through [0051]).

C) Claim 38

In accordance with yet another exemplary embodiment, claim 38 recites a method for marketing, comprising:

- defining a match between a user classification and a redeemable electronic coupon;
- receiving user data associated with a user's content selections;
- receiving the user's credit card purchase records describing purchases from retail stores;
- classifying the user in a user classification when the user's content selections relate to the user's purchases from the retail stores; and
- transmitting the redeemable electronic coupon to the user if a match is defined between the user classification and the electronic coupon.

Textual support for claim 38 is provided. A match is defined between a user classification and a redeemable electronic coupon (*see, e.g.*, paragraph [0006] at page 2, lines 25-30; paragraph [0015] at page 5, lines 6-7; paragraph [0030] at page 7, lines 21-22; paragraph [0044] at page 12, lines 20-31; at paragraphs [0052] through [0054]; at paragraph [0059]; and at FIG. 6). User data associated with a user's content selections is received (*see, e.g.*, paragraph [0033] at page 8, lines 23-24; paragraph [0034] at page 9, lines 12-15; at paragraphs [0035], [0041], [0042], and [0049]; and at FIGS. 1-3). The user's credit card purchase records describing purchases from retail stores are received (*see, e.g.*, paragraph [0016] at page 5, lines 15-25; paragraph [0034] at page 9, lines 10-25; and at paragraphs [0035] and [0051]). The user is classified in a user classification when the user's content selections relate to the user's purchases from the retail stores (*see, e.g.*, paragraph [0016] at page 5, lines 15-25; paragraph [0020] at page 6, lines 6-10; paragraph [0033] at page 8, lines 23-24; paragraph [0034] at page 9, lines 12-15; and at paragraphs [0035], [0041], [0042], and [0049]). The redeemable electronic coupon is

transmitted to the user if a match is defined between the user classification and the electronic coupon (*see, e.g.*, paragraph [0029] at page 7, lines 7-9; paragraph [0033] at page 9, lines 2-9).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Appellant appeals the final rejection of claims 1-4, 6-15, and 18-38 under 35 U.S.C. § 103 (a) as being obvious over WO 99/45702 to Knudsen.

ARGUMENT

- Knudson*, Even When Coupled with Assertions of “Official Notice,” Does Not Teach or Suggest All the Features of the Independent Claims, so the § 103 (a) Rejection is Improper**

The pending claims distinguish over the cited document to *Knudson*. As the Appellant below shows, the cited document to *Knudson*, even when coupled with the Examiner's assertions of “Official Notice,” does not teach or suggest all the features of the independent claims. One of ordinary skill in the art, then, would not think that the pending claims are obvious in view of *Knudson*.

The Office has finally rejected claims 1-4, 6-15, and 18-38 under 35 U.S.C. § 103 (a) as being obvious over WO 99/45702 to Knudsen. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”).

Independent claims 1, 15, and 38 are not obvious in view of *Knudson*. All the independent claims recite features not taught or suggested by *Knudsen*. All the independent claims, for example, recite “*receiving the user’s credit card purchase records describing purchases from retail stores.*” Moreover, all the independent claims also recite features for “*classifying the user in a user classification when the user’s television viewing selections relate to the user’s purchases from the retail stores.*”

The *Knudson* document completely fails to teach or suggest such features. As the Appellant has previously agreed, the Office is correct in recognizing that *Knudsen* receives “information regarding programs that have been purchased and viewed.” *Knudsen* at page 10, lines 8-11. *Knudsen* also describes an “order processing and billing system” for pay-per-view programming. *Knudsen* at page 9, lines 5-8. *Knudsen*, however, fails to realize that users can be classified according to “*purchases from the retail stores.*” The independent claims all recite features for “*receiving the user’s credit card purchase records describing purchases from retail stores*” and for “*classifying the user in a user classification when the user’s television viewing selections relate to the user’s purchases from the retail stores.*” *Knudson* is completely silent to such features.

The Appellant must strongly, yet respectfully, disagree with the position of the Examiner. The Examiner makes conclusions that are not logically supported by the evidence. In the December 19, 2005 final office action, for example, Examiner Alvarez asserts that such claimed features are obvious in view of *Knudson* when coupled with “Official Notice.” The Assignee and Examiner Alvarez both agree that *Knudson* teaches targeting incentives to viewers based on pay-per-view programming. *See, e.g., Knudsen* at page 10, lines 8-11. Examiner Alvarez, however, takes “Official Notice” that credit cards are a well known method of making purchases. *See* Examiner Alvarez, December 19, 2005 office action, at page 3, lines 7-9. Examiner Alvarez also takes “Official Notice” that monitoring purchases at retail establishments is a well known method of tracking customer purchases. *See id.* at lines 9-11. Examiner Alvarez then asserts that it would have been obvious to modify *Knudson* to include credit card purchases at made at retail establishments. *See id.* at lines 11-16.

The Appellant strongly and, yet, respectfully, disagrees. Whether or not credit card purchases are well-known, and whether or not monitoring purchases at retail establishments is well known, Examiner Alvarez's conclusion is faulty. The *Knudson* document targets incentives to viewers based on pay-per-view purchases. *Knudson*, however, makes no teaching or suggestion that relates "*the user's television viewing selections ... to the user's purchases from the retail stores,*" as the independent claims recite. Moreover, *Knudson* combined with the Examiner's assertions of "Official Notice" still fails to teach or suggest "*classifying the user in a user classification when the user's television viewing selections relate to the user's purchases from the retail stores.*" So, whether or not Examiner Alvarez's assertions of "Official Notice" are accurate, the teachings of *Knudson*, coupled with the assertions of "Official Notice," do not support her obviousness conclusion. *Knudson* is completely silent to any relation between television viewing selections and purchases from retail stores, so one of ordinary skill in the art would not have been led to modify *Knudsen* as suggested. Examiner Alvarez's assertions of "Official Notice" do not logically support the § 103 (a) rejection.

The final rejection, then, is improper. The teachings of *Knudsen*, even when coupled with Examiner Alvarez's assertions of "Official Notice," do not teach or suggest "*receiving the user's credit card purchase records describing purchases from retail stores*" and "*classifying the user in a user classification when the user's television viewing selections relate to the user's purchases from the retail stores,*" as set forth in the independent claims. One of ordinary skill in the art, then, would not think that independent claims 1, 15, and 38 are obvious in view of the cited document. Thus, the Appellant respectfully asserts that the § 103 (a) rejection is improper and should be removed on appeal.

The dependent claims are, likewise, not obvious. Claims 2-4, 6-14, and 18-37 depend from and include all the features of independent claims 1 and 15, respectively. Therefore, the § 103 (a) rejection of these claims is considered improper for at least the reasons given above. The Appellant thus respectfully asserts that the rejection of these claims should be removed on appeal.

2. Because No “Teaching, Suggestion, or Motivation” was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner has failed to properly make a *prima facie* case for obviousness. The Examiner's *prima facie* case for obviousness must include “some teaching, suggestion, or motivation” to combine prior art that is found “either in the references themselves or in the knowledge generally available to one of ordinary skill.” DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”).

Here the Examiner's *prima facie* case fails to include any teaching, suggestion, or motivation. The § 103 (a) final rejection merely states that it would have been obvious to modify *Knudsen* in view of the assertions of “Official Notice” to “better target the customers based on if they have credit and to keep track of the purchases made at retail stores in order to better target customer based on how they pay for the purchases and the retail establishments that they purchase from.” See Examiner Alvarez, December 19, 2005 office action, at page 3, lines 11-17. This reasoning, however, is purely conjecture. Examiner Alvarez cites no passage from *Knudsen* to support her *prima facie* burden. Examiner Alvarez also fails to assert anything found in the knowledge generally available to one of ordinary skill. The *prima facie* case for obviousness, then, is at least improper for failing to provide any teaching, suggestion, or motivation to combine, as M.P.E.P. § 2143 requires. The Appellant thus respectfully asserts that the § 103 (a) rejection of claims 1-4, 6-15, and 18-38 should be removed on appeal.

3. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner's *prima facie* case for obviousness is defective for another reason. The Examiner's *prima facie* case for obviousness must include “a reasonable expectation of success.” DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th

Edition). Here, however, the Examiner's *prima facie* case wholly fails to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* case for obviousness must fail. The Appellant thus respectfully asserts that the § 103 (a) rejection of claims 1-4, 6-15, and 18-38 should be removed on appeal.

4. There Can Be No Reasonable Expectation of Success, so the Pending Claims Cannot be Obvious

Knudsen, even when combined with the assertions of "Official Notice," cannot support a reasonable expectation of success. Again, there must be a reasonable expectation of success when combining documents. See M.P.E.P. § 2143. The Examiner's *prima facie* case, however, can have no expectation of success. Even if the Examiner's assertions of "Official Notice" are true, *Knudsen*'s specification fails to disclose how "*credit card purchase records describing purchases from retail stores*" would be obtained and used. Moreover, *Knudsen* also fails to teach how "*the user's television viewing selections [would be] relate[d] to the user's purchases from the retail stores.*" So, even if the Examiner's assertions of "Official Notice" are true, *Knudsen*'s specification fails to disclose how the user's "*credit card purchase records*" would be obtained and related to "*the user's television viewing selections.*" Because *Knudsen* is silent to such teachings, there can be no reasonable expectation of success when making the modification suggested by Examiner Alvarez. The Assignee thus asserts that the *prima facie* case for obviousness fails, so the § 103 (a) rejection of claims 1-4, 6-15, and 18-38 should be removed on appeal.

CONCLUSION

In view of the foregoing reasons, the Appellant respectfully requests reversal of the § 103 (a) rejections of claims 1-4, 6-15, and 18-38.

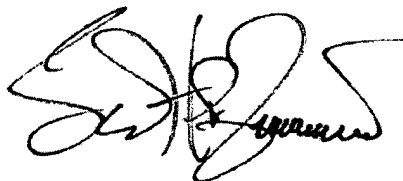
AUTHORIZATION FOR PAYMENT OF FEES

U.S. Application No. 10/017,111 Examiner ALVAREZ, Art Unit 3622
Appellant's Brief in Support of Appeal

If there are any other fees due in connection with the filing of this brief in support of appeal, please charge the fees to the credit card identified in the Credit Card Payment Form submitted herewith. If any additional fees are required, such as a fee for an extension of time under 37 C.F.R. § 1.136, such extension of time is requested and the fee should also be charged to the credit card on file.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

Scott P. Zimmerman
Attorney for the Assignee/Appellant
Reg. No. 41,390

CLAIMS APPENDIX

U.S. Patent Application No. 10/017,111 Pending Claims

1. A method for marketing, comprising:
 - defining a match between a user classification and an incentive;
 - receiving from a set-top box user data associated with a user's television viewing selections;
 - receiving the user's credit card purchase records describing purchases from retail stores;
 - classifying the user in a user classification when the user's television viewing selections relate to the user's purchases from the retail stores; and
 - transmitting the incentive to the user if a match is defined between the user classification and the incentive.
2. The method of claim 1, wherein the user's television viewing selections comprises a channel viewed by the user, a program shown on the channel, and the amount of time the channel is watched.
3. The method of claim 1, further comprising collecting the user data.
4. The method of claim 1, wherein the user's television viewing selections comprises how much of an advertisement the user views.
5. (Canceled)

6. The method of claim 1, wherein said step of classifying the user further comprises relating the credit card purchase records and the user's television viewing selections if the user views advertisements for a product and purchases the product.
7. The method of claim 1, wherein said step of classifying the user further comprises classifying the user in the user classification if the user data satisfies a predefined parameter, the parameter defining television viewing habits for the user classification.
8. The method of claim 1, wherein the user data comprises whether a product associated with the incentive was purchased.
9. The method of claim 1, wherein the user data comprises global computer network viewing data.
10. The method of claim 1, wherein the user data comprises survey data.
11. The method of claim 1, wherein the user data comprises a price paid for a product and a time the product was purchased.
12. The method of claim 1, wherein the incentive comprises an image embedded into television media content.
13. The method of claim 1, wherein the incentive comprises a redeemable electronic coupon.
14. The method of claim 1, wherein the incentive comprises a banner.
15. A system for delivering targeted incentives to a user, comprising:
 - a server in communication with a set-top box;

user data stored on the server, wherein said user data is collected from a plurality of sources comprising the user's television viewing selections from the set-top box and the user's credit card purchase records describing purchases from retail stores; and

a classification module in communication with the server configured for defining a match between a user classification and an incentive, and classifying the user in the user classification when the user's television viewing selections relate to the user's purchases from the retail stores.

16. (Canceled)
17. (Canceled)
18. The system of claim 15, wherein said classification module is further configured for relating the user's credit card purchase records and the user's television viewing selections if the user views advertisements for a product and purchases the product.
19. The system of claim 15, wherein said classification module is further configured for classifying the user in the user classification if the user data satisfies a predefined parameter, the parameter defining television viewing habits for the user classification.
20. The system of claim 15, wherein the user data comprises whether a product associated with the incentive was purchased.
21. The system of claim 15, wherein the user data comprises global computer network viewing data.
22. The system of claim 15, wherein the user data comprises survey data.
23. The system of claim 15, wherein the user data comprises a price paid for a product and a time the product was purchased.

24. The system of claim 15, wherein the incentive comprises an image embedded into television media content.
25. The system of claim 15, wherein the incentive comprises a video program.
26. The system of claim 15, wherein the incentive comprises a banner.
27. The system of claim 15, wherein the incentive comprises a coupon.
28. The method of claim 1, wherein the incentive comprises a video program.
29. The method of claim 1, wherein the user's television viewing selections comprise video games.
30. The method of claim 1, wherein the user's television viewing selections comprise audio content.
31. The method of claim 1, further comprising identifying the incentive by a product.
32. The method of claim 1, further comprising identifying the incentive by a demographic.
33. The method of claim 1, wherein the step of transmitting the incentive to the user comprises transmitting the incentive by mail.
34. The method of claim 1, wherein the step of transmitting the incentive to the user comprises transmitting the incentive by electronic message.
35. The method of claim 1, further comprising receiving records related to a shopping card in which the user is given a discount in exchange for using the shopping card.

36. The method of claim 1, further comprising receiving separate identification codes identifying each user of a common user terminal.
37. The system of claim 15, wherein the server receives separate identification codes identifying each user of a common user terminal.
38. A method for marketing, comprising:
 - defining a match between a user classification and a redeemable electronic coupon;
 - receiving user data associated with a user's content selections;
 - receiving the user's credit card purchase records describing purchases from retail stores;
 - classifying the user in a user classification when the user's content selections relate to the user's purchases from the retail stores; and
 - transmitting the redeemable electronic coupon to the user if a match is defined between the user classification and the electronic coupon.

EVIDENCE APPENDIX

There are no submissions pursuant to 37 CFR § 41.37 (c) (ix) for U.S. Patent Application No. 10/017,111.

RELATED PROCEEDINGS APPENDIX

There are no submissions pursuant to 37 CFR § 41.37 (c) (x) for U.S. Patent Application No. 10/017,111.